

## Articles

April 23, 2014

### First AIA Roundtable Hints at More Conservative Approach to PTAB Review

On April 15, 2014, the Patent Trial and Appeal Board (“PTAB”) hosted the first in a series of eight scheduled roundtable discussions intended to share information about the new America Invents Act (“AIA”) trials, including *inter partes* review (“IPR”), covered business method review (“CBM”) and post-grant review (“PGR”), and to solicit feedback about the trials from the public.

The PTAB held the first roundtable at the USPTO Headquarters in Alexandria, Virginia. It featured a panel of five administrative patent judges: Acting Vice Chief Judge of the Trial Section Scott Boalick, Lead Judge Grace Obermann, Lead Judge Michael Kim, Judge Justin Arbes and Chief Judge James Donald Smith. Janet Gongola moderated the panel. She is a senior advisor to the Deputy Director of the USPTO. The USPTO will hold the remaining roundtable discussions around the country through April and early May.

At the forum, Ms. Gongola noted that since the final rules for AIA trials went into effect on September 16, 2012, the PTAB has received more than 1,200 petitions for trial, issued almost 500 decisions on institution, and reached 40 final decisions. This summer, the PTAB will publish Requests for Information (“RFIs”) in the Federal Register for written comments on the trials as a supplement to the public feedback elicited from the roundtable events. The roundtables will help to highlight areas the PTAB should focus on in the RFIs this summer. Slides from the first roundtable presentation can be found [here](#).

The first roundtable event suggests that with the steep increase in the number of petitions filed for AIA trials this year (the number of petitions filed in 2014 by the beginning of April already equals the number of petitions filed in all of 2013), we may see the allegedly pro-petitioner bent of AIA trials begin to trend back the other way. Pro-petitioner outcomes may begin to level off for two reasons.

First, in the early days of AIA trials, defendants with particularly strong invalidity cases presumably self-selected to petition for IPR. Now that filing IPR petitions has become more common, we may see a decrease in the percentage of IPR trials instituted, perhaps in combination with a decrease in the percentage of claims ultimately found to be unpatentable, as a result of petitioners bringing weaker cases. The recent decision in the *ABB* cases marks the first time the PTAB upheld the validity of all claims involved in an IPR. See *ABB Inc. v. Roy-G-Biv Corp.*, P.T.A.B., No. IPR2013-00062, 4/11/14, and *ABB Inc. v. Roy-G-Biv Corp.*, T.A.B., No. IPR2013-00074, 4/11/14.

Second, the PTAB may become more conservative with instituting trials and finding claims unpatentable, in response to the common characterization of AIA trials as overwhelmingly pro-petitioner. The panel appeared to be on the defensive from Federal Circuit Chief Judge Randall Rader’s October 2013 statement at the AIPLA annual meeting, calling the PTAB “death squads killing property rights.” Chief Judge Smith emphasized the PTAB’s careful approach to evaluating the patentability of claims, stating that “I personally do not believe if by ‘death squad’ you mean there’s an intention to find claims unpatentable. Absolutely not. The board approaches its decision in a very neutral manner.” In his presentation, Judge Boalick was also quick to note that although 167 patents have been brought to the PTAB for IPR since implementation of the AIA trials, only nine of those patents have been completely invalidated, with only 15% of claims initially challenged ultimately found to be unpatentable.

Chief Judge Smith hinted at one way in which the PTAB might seek to even the playing field for patent owners: clearing the way for patent owners to amend their claims during IPR.

Currently, a patent owner has a very limited ability to amend its claims. The IPR process does not provide for claim amendments as a matter of right, so a patent owner must move to amend its claims. Further, the PTAB has set a high bar for the patentee to prove patentability of the amended claims. Instead of merely having to overcome the references identified by the petitioner, the patent owner in IPR

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has the burden to prove “general patentability over prior art” in order for the PTAB to grant the motion to amend.

At the roundtable, Chief Judge Smith noted that “making an amendment may be easier than is currently perceived by many” and suggested that an upcoming PTAB decision may provide guidance on how patent owners can successfully amend claims. Venable will monitor decisions and report on any such changes.

<b>Locations of Upcoming AIA Trial Roundtables</b>		
<b>Location</b>	<b>Date</b>	<b>Venue</b>
Chicago, IL	Tuesday, April 22	Chicago Public Library Cindy Pritzker Auditorium 400 S. State St. Chicago, IL 60605
Detroit, MI	Thursday, April 24	Cooley Law School 2630 Featherstone Rd. Auburn Hills, MI 48326
Silicon Valley, CA	Tuesday, April 29	Santa Clara University Nobili Hall 500 El Camino Real Santa Clara, CA 95053
Seattle, WA	Thursday, May 1	University of Washington Odegaard Undergraduate Library 4060 George Washington Ln. NE Seattle, WA 98195
Dallas, TX	Tuesday, May 6	Dallas Bar Association Belo Mansion 2101 Ross Ave. Dallas, TX 75201
Denver, CO	Thursday, May 8	Colorado Bar Association Office 1900 Grant St. Denver, CO 80203